

REMARKS

This paper is filed in response to the Office Action dated June 18, 2003. As this paper is filed on November 18, 2003, and is accompanied by a petition for a two-month extension and fee (\$420), the paper is timely filed.

I. Status of Amendments

Claims 1-36 were pending prior to this amendment. By this amendment, applicant cancels claims 5-7, 9, 37-42, amends claims 8, 12 and 22, and adds claims 43-52. Thus, claims 1-4, 8, 10-36, and 43-52 are now pending.

Because applicant previously paid fees for 4 independent and 42 total claims, no additional fee is required by applicant's amendments.

II. Response to Office Action

A General Comments

Although the application describes various embodiments and makes various statements regarding the "invention," it is well settled that the legal scope of the invention is defined by the words of the claims and that it is improper to read features of the embodiments described in the specification into the claims. It should also be recognized that the term "invention" may be used to mean various different things.¹ For example, the term "invention" may be used to refer to the technical subject matter that has been invented; the

¹ This is explained in the Glossary of Volume 1 of Chisum on Patents, where the term "invention" is defined as follows:

INVENTION – In patent law, the word 'invention' has several different meanings. It may refer to (1) the act of invention through original conception and reduction to practice; (2) subject matter described and/or claimed in a patent, patent application or prior art reference (e.g., a product or process); or (3) the patentability requirement of invention, first developed by the courts and now subsumed in the statutory requirement of nonobviousness. Thus, an applicant may have invented (1) an invention (2) which is unpatentable for lack of invention (3) because it is an obvious modification of an invention (2) used by others in this country before the invention (1) thereof by the applicant.

term “invention” may be used to refer to subject matter which is nonobvious; and the term “invention” may be used to refer to subject matter defined by the claims of a patent. Thus, the mere fact that the present application uses the term “invention” in various statements does not mean that the scope of the claims is limited by such statements.

It should also be understood that, unless a term is expressly defined in the application using the sentence “As used herein, the term ‘ _____ ’ is hereby defined to mean...” or a similar sentence, there is no intent to limit the meaning of that term, either expressly or by implication, beyond its plain or ordinary meaning, and such term should not be interpreted to be limited in scope based on any statement made in any section of the present application (other than the language of the claims). Finally, unless a claim element is defined by recital of the word “means” and a function without the recital of any structure, it is not intended that the scope of any claim element be interpreted based on the application of 35 U.S.C. § 112, sixth paragraph.

It is respectfully submitted that the foregoing comments regarding claim construction are consistent with 35 U.S.C. §112 and the Office practice of utilizing the “broadest reasonable interpretation” of claims.

It is also respectfully submitted that the claims are supported by the application, that the claims satisfy the written description requirement and the other requirements of 35 U.S.C. §112, and that no new matter is being added. In this regard, it is well settled that the specification need not reproduce the exact language of the claims to satisfy the written description requirement of §112, first paragraph. In re Wright, 9 U.S.P.Q.2d 1649, 1651 (Fed. Cir. 1989) (“[T]he claimed subject matter need not be described in haec verba in the specification in order for that specification to satisfy the description requirement.”). The written description requirement of §112 can even be satisfied based solely on the drawings of a patent application. Vas-Cath Inc. v. Mahurkar, 19 U.S.P.Q.2d 1111, 1118 (Fed. Cir. 1991) (“These cases support our holding that, under proper circumstances, drawings alone may provide a ‘written description’ of an invention as required by §112”).

B. The June 18 Office Action

In the June 18 Office Action, claims 1-39, 41, and 42 were rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Baerlocher et al. (U.S. Patent No. 6,406,369). Claim 40 was rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Baerlocher et al. in view of Olsen (U.S. Patent No. 6,210,275). Applicants respectfully disagree.

In the June 18 Office Action, it is conceded that Baerlocher et al. does not disclose, teach or suggest each and every limitation of, for example, claim 1. In particular, it is stated that “Baerlocher lacks a player selectable characters.” June 18 Office Action, at 2. To supply the missing disclosure, the statement is made that “it is notoriously well known in fighting games that players can select a game character that the player will use to compete against opposing game characters in order to give the player the best chance of winning the game.” June 18 Office Action, at 3. It is further suggested that “[o]ne would be motivated to combine the features in order to allow a player the opportunity to select a game character in order to allow the player the best opportunity to win the game.” Id.

Applicant submits that the reliance on what is “notoriously well known” for the missing disclosure and the motivation to combine that disclosure with Baerlocher et al. runs contrary to the law on this issue. In particular, in In re Lee, 61 USPQ2d 1430, 1434-35 (Fed. Cir. 2002), the Federal Circuit stated that “deficiencies of the cited references cannot be remedied by . . . general conclusions about what is ‘basic knowledge’ or ‘common sense’.” The Federal Circuit particularly found fault with the suggestion that there is no need for a “specific hint or suggestion in a particular reference” to support a combination of references. Id. at 1434. Accordingly, applicant respectfully submits that it would be improper for the examiner to rely on what is “notoriously well known” for the missing disclosure and the motivation (“best chance of winning”) to combine the allegedly “notoriously well known” disclosure with that of Baerlocher et al.

Furthermore, applicants submit that the combination suggested in the June 18 Office Action runs contrary to Baerlocher et al., such that such a combination is improper under the circumstances of this application. In particular, Baerlocher et al. states, for example, at col. 7:26-42:

The leader board 52 displays a plurality of competitors generally indicated by symbols such as numbers 56 who are competing with the player who is represented by a symbol such as a number 58 for the most valuable position. The positions are ranked in accordance with a series of multipliers generally indicated by number 60, which will ultimately provide the player's bonus. . . . In the preferred embodiment, the driver in the last or ninth position 54, has the lowest multiplier 60, here a 1X, while the driver in the highest or first position 54, as the highest multiplier 60, here a 500X. At the end of the bonus round, the position of the player determines the player's bonus scheme award.

Given that that the bonus depends on the player's ranking and that the player's ranking is related to the symbol associated with the player, if the player were permitted to select any one of the symbols to be associated with him or herself for the bonus game, then doing so would be more than providing a "best chance of winning." Permitting the player to select the symbol associated with him or herself would be tantamount to permitting the player to select the bonus prize to be awarded, and presumably the player would be motivated to select the highest position to ensure the largest bonus. Thus, Baerlocher et al. states (at col. 10:53-56) that "[t]he game displays the number of positions 54 and the bonus multipliers 60 to the player, and *places the player* in the last position (i.e., 1X multiplier) as indicated by block 104."

For the foregoing reasons, Baerlocher et al. does not disclose, teach or suggest each and every limitation of the claimed subject matter of claim 1, and the combination proposed is improper. Consequently, the subject matter of claim 1 is allowable.

While not admitting to the correspondence alleged at page 5 of the June 18 Office Action between claims 1 and 15, similarities between independent claim 1 and independent claims 15 and 43 suggest that claims 15 and 43 are also allowable. Claim 15, similar to claim 1, recites "in association with play of said bonus game, providing said player an opportunity to select a bonus game character" Likewise, claim 43 recites "at least one bonus game input device engageable by a player to select a bonus game character to represent said player" Therefore, applicant respectfully submits that the arguments made relative to claim 1 above apply with equal force to claims 15 and 43.

As to claim 29, it is suggested in the June 18 Office Action that "[claim] 29 . . . correspond[s] in scope to a method of conducting a game set forth for use of the method listed in the claims above and are encompassed by use as set forth in the rejection above."

June 18 Office Action, at 5. This is not correct, as claim 29 differs in scope from that set forth in claim 1, and Baerlocher et al., even as allegedly modified by the “notoriously well known . . . fighting games,” does not disclose, teach or suggest each and every element of the claimed subject matter. For example, unlike claim 1 and unlike modified Baerlocher et al., claim 29 recites “providing a plurality of gaming machines . . . [and] at least one display for exhibiting at least one competition between at least two different characters, each of said at least two different characters being associated with a gaming machine of said plurality of gaming machines.” Consequently, the rejection over modified Baerlocher et al. was not and is not applicable relative to claim 29, and modified Baerlocher et al. fails to disclose, teach or suggest each and every limitation of claim 29; thus, the rejection should be withdrawn.

Finally, claims 2-4, 8, and 10-14 depend from claim 1, claims 16-28 depend from claim 15, claims 30-36 depend from claim 29 and claims 44-52 depend from claim 43. Given that claims 1, 15, 29, and 43 are allowable, so too are the claims that depend from these claims. Consequently, the Examiner is respectfully requested to allow these claims.

In view of the foregoing, it is respectfully submitted that the above application is in condition for allowance, and reconsideration is respectfully requested. If there is any matter that the Examiner would like to discuss, the Examiner is invited to contact the undersigned representative at the telephone number set forth below.

Respectfully submitted,

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